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S&H Form: (2/01)

Docket No.: 1293.1215

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

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Sung-hee Hwang et al.

AUG 10 2004

Serial No. 10/022,826

Group Art Unit: 2133

Technology Center 2100

Confirmation No. 1431

Filed: December 20, 2001

Examiner: Torres, Joesph D.

For: OPTICAL RECORDING MEDIUM, DATA RECORDING OR REPRODUCING
APPARATUS, AND DATA RECORDING OR REPRODUCING METHOD USED BY THE
DATA RECORDING OR REPRODUCING APPARATUS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed July 8, 2004, having a shortened period for response set to expire on August 8, 2004, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect claims 1-45 (Group I) in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Insofar as Group II is concerned, it is believed that claims 46 and 47 are so closely related to elected claims 1 through 45 that they should remain in the same application. The elected claims 1 through 45 are directed to, for example, a method of recording data on an optical disc and claims 46 and 47 are drawn to a method of reproducing data from a medium. There have been no references cited to show any necessity for requiring restriction. While it is noted that the Examiner has identified different classifications, it is believed that classification is not conclusive on the question of restriction. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Group II claims by filing a divisional application. This is particularly true in

light of the fact that many patents have issued which are directed to both recording and reproducing.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

Even if the Examiner considers claims 46 and 47 to be a separate invention from claims 1 through 45, the Applicants respectfully request the Examiner to consider claims 1 through 45 (Group I) and 46 and 47 (Group II) together.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the method recited by the Group II claims is directed to a method of reproducing data from a medium, and elected claims 1 through 45 are directed to, for example, a method of recording data on an optical disc, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 8-6-04

By: 

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